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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,735	04/02/2004	Carl Diez	4510-0117PUS1	1543

2292 7590 01/06/2006

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EXAMINER
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DUNWOODY, AARON M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,735	<b>Applicant(s)</b> DIEZ, CARL	
	<b>Examiner</b> Aaron M. Dunwoody	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-23 and 25-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the plane" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Further, in regards to claim 20, it is not clear to the Examiner how a curved surface can have a plane. A curved surface that intersects a plane will only have point or line contact, therefore, the Examiner will assume the Applicant is referring to point contact for examination purposes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-23, 25-27 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication US 2004/0208728 A1, Fattori et al.

In regards to claim 20, Fattori et al disclose a coupling (10) comprising:

a tubular member (20) having two opposite open ends, defining a geometrical longitudinal axis, having an outer surface, having a first section, a second section, wherein each of the first and second sections comprises on its outer surface:

at least one staple (26, 30) comprising a mechanically compliant convex wall slanted in a direction of insertion of the tubular member in the corrugated conduits through the open ends of the conduits, and the mechanically compliant convex wall comprises:

an elongated wall base connected to the outer surface of the tubular member;  
a sloping convex surface, which slopes upward from a plane of the elongated wall base; and  
a free edge.

Note, **the corrugated conduits are not part of the claimed invention, and not considered by the Examiner.**

In regards to claim 21, Fattori et al disclose the elongated wall base being a curved base.

In regards to claim 22, Fattori et al disclose the free edge of the mechanically compliant convex wall being a curved edge.

In regards to claim 23, Fattori et al disclose the free edge of the mechanically compliant convex wall lying in a plane substantially perpendicular to the geometrical longitudinal axis of the tubular member.

In regards to claim 25, Fattori et al disclose each of the first and second sections of the tubular member comprising a plurality of staples distributed on the outer surface of the tubular member along a circle centered on the geometrical longitudinal axis.

In regards to claim 26, Fattori et al disclose the tubular member further comprising at least one stopper (28) on the outer surface of the tubular member between the first and second sections of the tubular member, the open end of the each of the first and second corrugated conduits having a free edge abutting against the at least one stopper upon inserting the corresponding tubular member in the corrugated conduit through the open end of the corrugated conduit to limit the course of the tubular member within the corrugated conduit.

In regards to claim 27, Fattori et al disclose the axial distance between the at least one stopper and the at least one staple of each of the first and second sections being so selected that the at least one staple is located in one of the valleys of the inner

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surface of the corrugated conduit when the free edge of the open end of the corrugated conduit abuts against the at least one stopper.

In regards to claim 31, Fattori et al disclose each of the first and second sections comprising, at the corresponding open end, a beveled rim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fattori et al.

In regards to claim 28, Fattori et al disclose the claimed invention except for the at least one stopper comprising a plurality of tabs projecting radially from the outer surface of the tubular member and distributed along a circle centered one the geometrical longitudinal axis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the at least one stopper with a plurality of tabs projecting radially from the outer surface of the tubular member and distributed along a circle centered one the geometrical longitudinal axis, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

In regards to claim 29, Fattori et al disclose each of the first and second sections further comprises a plurality of axial ribs of guidance (92) circumferentially distributed on

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the outer surface of the tubular member, the ribs of guidance sliding on the inner surface of the corrugated conduit upon-inserting the corresponding section of the tubular member in the corrugated conduit through the open end of the corrugated conduit.

In regards to claim 30, Fattori et al disclose the ribs of guidance are beveled to facilitate insertion of the tubular member through the open end of the corrugated conduit.

### ***Response to Arguments***

Applicant's arguments filed 10/27/2005 have been fully considered but they are not persuasive.

Applicant argues that Fattori et al does not disclose the following:

- 1) wherein each of said first and second sections comprises on its outer surface;
- 2) at least one staple comprising a mechanically compliant convex wall slanted in a direction opposite to a direction of insertion of the tubular member in said corrugated conduits through the open ends of said corrugated conduits; and
- 3) a sloping convex surface which slopes upward from the plane of the elongated wall base.

The Examiner disagrees. In Figures 2-7, Fattori et al clearly illustrates each of said first and second sections comprising on its outer surface; at least one staple comprising a mechanically compliant convex wall slanted in a direction opposite to a direction of insertion of the tubular member in said corrugated conduits through the open ends of

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said corrugated conduits; and a sloping convex surface which slopes upward from the plane of the elongated wall base.

Applicant argues that the resilient arms of Fattori et al are not located on the surface of the coupling. The Examiner disagrees. The Applicant states:

Instead, they are cut out from the body of the fastener, or as stated in the reference itself, 'formed in and extending from a sidewall of said [first and second] tubular portion toward an outer face of said flange'...

However, this is a misrepresentation of the Fattori et al invention. Fattori et al recites:

[0041] The first tubular portion 22 includes the pair of opposed resilient first arms 26 each of which extend in the direction towards the flange 28 from an end portion 40 thereof proximate the distal end 36 of the body 20. The first arms 26 reside in recesses 42 which are located on opposed sides of the first tubular portion 22 to allow the arms 26 to move freely therein. Each of the resilient first arms 26 includes a free end 44 having an outside surface which protrudes radially outward to form a lip and gradually tapers towards the end attached to the first tubular portion 22. As noted above, each free end 44 of the first arms 26 is adapted to bias radially outward with respect to the central axis of the first tubular portion 22. The free ends 44 of the first arms 26 further each include a retaining end surface 46 (shown best in FIG. 5) set apart opposite or spaced apart from the shoulder surface 32 of the flange 28. The retaining end surface 46 and the shoulder surface 32 of the flange 28 are adapted to cooperatively retain adjacent sidewall portions

[0042] The second tubular portion 24 includes the pair of opposed second resilient arms 30 each of which extends in the direction towards the flange 28 from an end portion 48 thereof proximate a distal end 38 of the body 20. The second arms 30 reside in recesses 50 which are located on opposed sides of the second tubular portion 24 to allow the arms 30 to move freely therein. Each of the resilient second arms 30 includes a free end 52 having an outside surface which protrudes radially outward to form a lip, and gradually tapers towards the end portion attached to the second tubular portion 24. As noted above, each of the second arms 30 is adapted to bias radially outward with respect to the central axis of the second tubular portion 24. The free end 52 of the second arms 30 further includes a retaining end surface 54 which is adapted to contact the inside surface of the sidewall 19 of the fence slat 14 for securely and captively retaining the second tubular portion 24.

The above recitation should be interpreted as the resilient arms of Fattori et al are located on the surface of the coupling, as clearly illustrated in Figures 2-7 of Fattori et al.

In response to Applicant's argument that Fattori et al does not solve the same problem as the Applicant's invention, it has been held that the mere fact that the reference relied on by the Patent and Trademark Office fail to evince an appreciation of the problem identified and solved by applicant is not, standing alone, conclusive



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evidence of the nonobviousness of the claimed subject matter. The references may suggest doing what an applicant has done even though workers in the art were ignorant of the existence of the problem. In re Gershon, 152, USPQ 602 (CCPA 1967).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the at least one stopper with a plurality of tabs projecting radially from the outer surface of the tubular member and distributed along a circle centered on the geometrical longitudinal axis, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

In response to applicant's argument that Fattori et al's rib is not for guidance, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

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